UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,895	03/31/2004	David Benjamin Auerbach	24207-10115	5766

62296   7590   01/12/2009
GOOGLE / FENWICK
SILICON VALLEY CENTER
801 CALIFORNIA ST.
MOUNTAIN VIEW, CA 94041

EXAMINER
ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
2169	

MAIL DATE	DELIVERY MODE
01/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/813,895	AUERBACH ET AL.
Office Action Summary	Examiner	Art Unit
	Greta L. Robinson	2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,18-20 and 36-67* is/are pending in the application.
    4a) Of the above claim(s) *1,18,38 and 39* is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *2, 3, 19, 20, 36, 37, 40-67* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *3/6/08*.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election with traverse of Invention II in the reply filed on October 17,

2008 is acknowledged. The traversal is on the ground(s) that Group I and Group II are

related and capable of use together. Applicant states each Group recites similar claim

elements directed to monitoring an application capturing an event, indexing event data

and storing. Applicant states claim elements are not identically recited, however Group

II includes additional process steps not found in Group I. This is not found persuasive

because each Group has been found to have a separate status in the art. Although

each group is directed to monitoring an application for events by capturing an event and

indexing, the resultant of such monitoring encompass different modes of operation.

Note Group I requires indexing at least some of the event data to a searchable index

and storing the searchable index to a storage medium. These features are not required

on Group II. Group II does not appear to require a "searchable index" or "storage" for

operation; but rather simply indexes and stores captured information to further perform

a specific search query procedure. Group II has been classified in 707/4 while Group I

can be classified in 707/100. Note Figures 2, 3, and Page 3 paragraphs 009-0010

appear to support distinct embodiments of the invention.

        The requirement is still deemed proper and is therefore made FINAL.

2.   This application contains claims 1, 18, 38 and 39 drawn to an invention

nonelected with traverse in the reply filed on October 17, 2008. A complete reply to the

final rejection must include cancellation of nonelected claims or other appropriate action

(37 CFR 1.144) See MPEP § 821.01.

3.   Claims 1-3, 18-20 and 36-37 are pending in the present application. *New* claims

40-67 have been added. Claims 1, 18, 38 and 39 have status *withdrawn*. Claims 4-17

and 21-35 have been cancelled. Claims 2, 3, 19, 20, 36, 37 40-67 have been examined.

Information Disclosure Statement

4.   The information disclosure statement (IDS) submitted on March 26, 2008 the

provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being

considered by the examiner.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

6.   Claims 2, 3, 36 and 40-53 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Independent claim 36 is directed to a *process*, however in order to be in

compliance with 37 CFR 101 a process <u>claim must</u> (1) be tied to another statutory class

(such as a particular apparatus) *or* (2) transform underlying subject matter (such as an

article or materials) to a different sites or thing. If neither of these requirements are met

by the claim, the method is not a patent eligible process under § 101 and should be

rejected as being directed to non-statutory subject matter. In the present case the claim

does not positively tie the statutory class to a particular hardware element which would

make the method steps tangible and does not transform the underlying data. Claims 2,

3 and 40-53 are rejected based on dependency. MPEP § 2106.IV.B. *In re Bilski.*

Claim Rejections - 35 USC § 112

7.   Claims 2, 3, 19, 20, 36, 37, 40-67 are rejected under 35 U.S.C. 112, second

paragraph, as being incomplete for omitting essential steps, such omission amounting

to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

independent claims 36 and 37 should include reference to an impicit query operation

and an explicit query operation. Support for this limitation can be found at page 7

paragraph [0017], page 28 paragraph [0050]. Claims 2, 3, 19, 20 and 40-67 are rejected

based on dependency.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

9.   Claims 36, 37, 40-53 and 54-67 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pingali et al. *Instantly Indexed Multimedia Databases of Real World

Events* in view of Kaler et al. US Patent 6,708,293 B2.

        Regarding claim 36, Pingali et al. teaches a method for processing media files

[Figure 1] comprising:

        monitoring at least one application for occurances of events wherein at least one

event is associated with a media file [note: abstract "We introduce a new paradigm for

real-time conversion of a real world event into a rich multimedia database by processing data

from multiple sensors **observing events**. Real-time analysis ... instant indexing of multimedia

data at capture time"; page 269 introduction "**real-time or online indexing**, as well as

capture of data and indices that support a **user's domain-specific queries**; note

tracking page 271-274 section V];

        capturing the at least one event upon the occurance of the event by queuing

event data associated with the event at a position in a queue [note: abstract "We

introduce a new paradigm for real-time conversion of a real world event into a rich multimedia

database by processing data from multiple sensors **observing events**. Real-time analysis …

instant indexing of multimedia data at capture time"; page 269 introduction "**real-time or**

online indexing, as well as **capture** of data and indices that support a **user's domain-**

specific queries"];

indexing and storing at least some of the event data and articles associated with

the event at a time after the occurance of the event, wherein the time is based on

performance data indicating a readiness to process the event and the position in the

queue [note: page 275 note data selection section VI and page 279 activity map based

indexing; user defines indexing criteria page 270-271 sections II-III];

receiving a search query [note: page 269 "real-time or online indexing, as well as

capture of data and indices that support a user's domain-specific queries"; Figure 2];

and

locating at least one relevant media file from the indexed and stored events

relevant to the search query [note: Figure 2; page 270; page 269 left column

paragraphs 3-4 system allows users to query a database and experience a live or

archived tennis match in multiple forms]; and

outputting a result comprising at least one relevant media file [note: page 269;

Figure 9].

Although Pingali et al. teaches the invention as cited, they do not explicitly teach

that the time is based on performance data. Kaler et al. teaches monitoring an

application includes monitoring performance data [see: abstract; Figures 16-19; column

3 lines 1-48; column 15 lines 16-27 custom fields may be defined]. It would have been

obvious to one of ordinary skill at the time of the invention to have combined Kaler et al.

with Pingali et al. since Pingali et al. teaches other domain specific information may be

defined for indexing and retrieval of real-time events and data; and Kaler et al. teaches

monitoring an application process encompasses monitoring performance.

10.   Regarding claims 40-53, wherein the event comprises monitoring an application

to determine the event data …. [note: Pingali et al. pages 270-271 tracking and

analyzing activity and 279-281 ability to track dynamic activity and define parameters

and/or sensors].

11.   The limitations of claim 37 and 54-67 parallel claims 36 and 40-53; therefor it is

rejected under the same rationale.

Allowable Subject Matter

12.   Claims 19 and 20 would be allowable if rewritten to overcome the rejection(s)

under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of

the limitations of the base claim and any intervening claims.

Response to Arguments

13.   Applicant's arguments with respect to claims 2, 3, 19, 20, 36, 37 40-67 are have

been considered but are moot in view of the new ground(s) of rejection. Note newly

cited reference Kaler et al. who teaches performance data as part of monitoring

process.

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Chaudhuri et al. US Patent Application Publication No. 2005/0192921 A1

15.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Greta L. Robinson whose telephone number is

(571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tony Mahmoudi can be reached on (571)272-4078. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greta L. Robinson/
Primary Examiner, Art Unit 2169a
Jaunary 9, 2009